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Supreme Court of the United States

October Term, 1955

No. 295

GEORGE WASHINGTON PIERCE,
PETITIONER,

v.

AMERICAN COMMUNICATIONS COMPANY, INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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Supreme Court of the United States

October Term, 1955

No. .....

GEORGE WASHINGTON PIERCE,
PETITIONER,
v.
AMERICAN COMMUNICATIONS COMPANY, INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The petitioner, George Washington Pierce, under the provisions of Rule 23 (5), files this single Petition for a Writ of Certiorari to review the single judgment (R. A134) of the United States Court of Appeals for the First Circuit, entered May 11, 1955, in two very related appeals from orders of the District Court for the District of Massachusetts, entitled as above, and numbered, on the docket of the said Court of Appeals, No. 4938 and No. 4939.

The said two appeals were briefed and argued together in the said Court of Appeals and were decided by a single *per curiam* opinion quoted hereinafter.

A certified transcript of part of the record in the said two appeals, including the proceedings in the said Court of Appeals, is furnished herewith in compliance with Rule 21 of the Rules of this Court. It is entitled, "Original Cer-

tified Copy of Record Appendices and Proceedings In Said Causes, To and Including June 1, 1955". Another part of the record is already before this Court, *American Communications Company, Inc. v. Pierce,* 208 F. 2d 763, certiorari denied, 347 U. S. 944, rehearing denied, 347 U. S. 970, 348 U. S. 851.

Reference will be made hereinafter to the "Appellant's Appendix To Brief" in the said other part of the record by a page number followed by a small letter "a" annexed; as, for example, 531a. Reference will be made to the said "Original Certified Copy of Record Appendices and Proceedings in Said Causes, To and Including June 1, 1955", by a page number preceded by a capital letter "A"; for example, A57.

I

OPINION BELOW

The District Court did not write an opinion (R. A57).

The opinion of the Court of Appeals for the First Circuit (R. A133), reported at 221 F. 2d 959, reads as follows:

> *Per Curiam.* The Order of the District Court entered on December 21, 1954, and the Judgment and Order on Mandate entered December 28, 1954, are affirmed.

II

JURISDICTION

The judgment of the Court of Appeals was dated and entered May 11, 1955 (R. A134).

The jurisdiction of this Court to review the above-mentioned decision of the Court of Appeals is invoked under the provisions of 28 U. S. C. Section 1254 (1).

Some of the previous decisions of this Court bearing on jurisdiction are:

With respect to Question I hereinafter presented, this Court has heretofore assumed jurisdiction to construe the Federal Rules of Civil Procedure,

Sibbach v. Wilson & Co., Inc., 312 U. S. 1.
Hickman v. Taylor, 329 U. S. 495.

The decision of the District Court denying the petitioner's hereinafter-described motion under the provisions of Rule 56(g) of the Federal Rules of Civil Procedure involved a separable and collateral controversy. *Cohen v. Beneficial Industrial Loan Corp.*, 337 U. S. 541, 546. *Swift & Company Packers v. Compania Colombiana Del Caribe, S. A.*, 339 U. S. 684, 688. *Roberts v. United States District Court for The Northern District of California*, 339 U. S. 844. *Stack v. Boyle*, 342 U. S. 1, 6. *Collins v. Miller*, C. A. Dist. of Col. Cir., 1952, 198 F. 2d 948, 949. *Youpe v. Moses*, C. A. Dist. Col. Cir., 1954, 213 F. 2d 613, 616.

The District Court, furthermore (A57), issued an order under the provisions of Rule 54 (b).

The issue raised by Question II is already before this Court, *Sears, Roebuck & Co. v. Bruce A. Mackey et al.*, No. 34, October Term, 1955, and there are pending also at least two further Petitions for Certiorari raising that issue, *The Cold Metal Process Company* and *The Union National Bank of Youngstown, Ohio, Trustee v. United Engineering & Foundry Company*, No. 76, October Term, 1955, and *Pierce v. Hewlett-Packard Company et al.*, No. 189, October Term, 1955.

III

QUESTIONS PRESENTED

I. Where a scientist, in consideration of a so-called "retainer in this case", and in the endeavor to influence the decision of the District Court upon a motion by the respondent for partial summary judgment under the provisions of Rule 56 of the Federal Rules of Civil Procedure, set forth, under oath, in an affidavit supporting the motion for partial summary judgment, and purporting to be on personal knowledge, statements of alleged fact that, however, turned out later to be inconsistent with and contradictory to the true facts contained in a scientific text book composed by that same scientist substantially contemporaneously with the preparation of the said affidavit, but published after the hearing upon the motion for partial summary judgment, was the said affidavit presented to the District Court in bad faith within the meaning of paragraph (g) of the said Rule 56?

II. Whether the decision of the Court of Appeals for the First Circuit was based upon an appeal from a judgment of the District Court that was not final, under a misconstruction of Rule 54(b) of the Federal Rules of Civil Procedure, contrary to the statutes and also to the construction of these statutes and said Rule by other Courts. Specifically, where suit is entered for infringement, by the same equipment, of a group of patents, and the District Court, under the provisions of Rule 56, enters an order, granting a motion for summary judgment with respect to some only of the claims of one only of the patents, but leaving completely unadjudicated the remaining claims of the said one patent and also all the claims in suit of the remaining patents:

A. Whether the said Rule 54(b) may be construed to authorize an express determination by the District Court that there is no just reason for delay, and the directing of an entry of judgment, thereby to render the said order final and appealable; and

B. Whether the said Rule 54(b), if so construed to render the said order final and appealable, is invalid and void, as contrary to 28 U. S. C., Section 1291.

IV

THE STATUTES AND THE FEDERAL RULES OF CIVIL PROCEDURE INVOLVED

Rule 54(b).

54(b) JUDGMENT UPON MULTIPLE CLAIMS. When more than one claim for relief is presented in an action, whether as a claim, counterclaim, cross-claim, or third-party claim, the court may direct the entry of a final judgment upon one or more but less than all of the claims only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment. In the absence of such determination and direction, any order or other form of decision, however designated, which adjudicates less than all the claims shall not terminate the action as to any of the claims, and the order or other form of decision is subject to revision at any time before the entry of judgment adjudicating all the claims.

Rule 56(g).

56(g). AFFIDAVITS MADE IN BAD FAITH. Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses

which the filing of the affidavits caused him to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

Statutes, 28 U. S. C., Sections 1254(1), 1291, 2071 and 2072 are quoted in the Appendix.

V

SUMMARY STATEMENT OF THE MATTERS INVOLVED

This is an action for patent infringement, brought by the petitioner. The complaint charges the respondent with manufacturing and selling equipment that infringes each of a group of patents. One of these, the basic patent 2,133,642 (R. 531a), issued October 18, 1938, covers a constant-frequency piezoelectric-crystal-controlled oscillator, which has become known to the art as the Pierce oscillator. The remaining patents cover subsidiary piezoelectric-crystal inventions.

Prior to the present litigation, the petitioner was held to be the first inventor of the Pierce oscillator covered by the thirteen claims 51, 52, 54, 55, 56 and 61 to 68, inclusive, of the basic patent 2,133,642 by three courts: first, the District Court for the District of Delaware, *Miller v. National Broadcasting Company, Inc., Miller v. R. C. A. Communications, Inc.*, 6 F. Supp. 47; secondly, by the Court of Appeals for the Third Circuit, 79 F. 2d 657, affirming this decision of the District Court; and, thirdly, by the Court of Customs and Patent Appeals, *Miller v. Pierce*, 97 F. 2d 141.

In the present litigation, Judge Ford, in the District Court for the District of Massachusetts, *Pierce v. American Communications Company, Inc.*, 111 F. Supp. 181, went

further and held, not only that the petitioner was the prior inventor of the Pierce oscillator represented by the said thirteen claims, but also that the Pierce oscillator constituted a very valuable invention, that was not anticipated by the prior art. Judge Ford held these thirteen claims to be valid and infringed.

On appeal, *American Communications Company, Inc. v. Pierce*, 208 F. 2d 763, *supra*, the Court of Appeals for the First Circuit, though vacating the judgment of the District Court upon other grounds, agreed that the petitioner was the inventor of the Pierce oscillator, and also that the Pierce oscillator is an important invention. The Court of Appeals described that invention, page 765, by such terms, for example, as "plaintiff's distinctive contribution to the art of frequency stabilization" and "a significant improvement over the prior art frequency-controlled oscillating circuits".

Question I

The Bad Faith Charged Under the Provisions of Rule 56(g) of the Federal Rules of Civil Procedure

The case was decided by Judge Ford, in the District Court for the District of Massachusetts, on motions by both parties for partial summary judgment with respect to the said thirteen claims only of the basic Pierce-oscillator patent 2,133,642 only. The motions for partial summary judgment were supported by affidavits under the provisions of Rule 56 of the Federal Rules of Civil Procedure. No oral testimony was offered by either party, and there was no opportunity for cross-examination.

Among the affidavits supporting the respondent's motion for partial summary judgment was an affidavit by Profes-

tors as distinguished from the history of the art", an explanation that is devastatingly refuted by Professor Edward L. Bowles, of the Massachusetts Institute of Technology (R. A50-A52); and,

Secondly (R. A56), "it would have been highly presumptuous for Prof. Edson * * * it would have been most highly improper for him to teach his students that not Prof. Pierce but that Prof. Nicolson or Prof. Cady was the inventor" of the Pierce oscillator, until Professor Edson had first succeeded in misleading the District Court ("before this Court passed on the question") as to that alleged fact.

Professor Edson had no intention, however, of endeavoring to mislead the scientists, the engineers and the students of the world as to who was the inventor of the Pierce oscillator, irrespective of his success or lack of success in his attempts to mislead the District Court as to that matter, because he did not even wait to learn how successful or unsuccessful he had been in his efforts to mislead the District Court. His text book was published the very next month after the hearings on the motions for summary judgment were over.

Promptly upon the publication of that text book, therefore, the petitioner (R. A14) invited the attention of the District Court thereto, charging bad faith, in that the statements contained in Professor Edson's affidavit were inconsistent with and contradictory to the statements contained in that same Professor Edson's text book. The charge of bad faith was supported by an affidavit of Professor Bowles (R. A15).

The District Court held a hearing, and took the matter under advisement (R. A64), but made no reference to Pro-

fessor Edson's text book in its before-mentioned decision, 111 F. Supp. 181.

Since the mandate of the Court of Appeals, 208 F. 2d 763, *supra*, had awarded costs to the respondent, however, the petitioner insisted that, before assessing those costs, the District Court should first, in accordance with Rule 56 (g) of the Federal Rules of Civil Procedure, ascertain the expense to which the petitioner has been subjected in his efforts, by means of affidavits and other documents, to controvert the false statements, on alleged personal knowledge, contained in Professor Edson's affidavit.

The petitioner's arguments as to bad faith on the part of Professor Edson were reinforced by affidavits of Professor Chaffee and additional affidavits of Professor Bowles (R. A22-A31, A43-A54), none of which were controverted. Among other allegations, Professor Chaffee said that Professor Edson, as a graduate student under him, had attained the degree of Doctor of Science, had been taught all about Professor Cady's inventions, and had even, in his Doctor's thesis, cited publications describing Professor Cady's inventions. Professor Chaffee said further that Professor Edson could not possibly, therefore, have honestly mistaken Professor Cady's and Mr. Nicolson's contributions for the Pierce oscillator; and Professor Bowles supplied concrete detailed evidence leading to the same conclusion. Professor Chaffee and Professor Bowles were offered at the hearing, in open court, for cross examination (R. A55), but the respondent did not care to cross examine.

There could not, therefore, be any doubt as to the truth of the statements of Professor Chaffee and Professor Bowles, proving that Professor Edson's affidavit was utterly false.

The petitioner invited attention also to a number of additional instances of attempts by the respondent to deceive the District Court (R. A32-A40).

Question II

The Court of Appeals Was Without Jurisdiction of the Appeal

It has been stated, on page 7, *supra*, that the decision of Judge Ford, on motion for partial summary judgment, covered thirteen claims only of one only of a group of patents. As stated on page 6, *supra*, however, the defendant's equipment is charged to be infringed by each of a group of patents. The remaining claims in suit of the said one patent and also all the claims in suit of the remaining patents, therefore, are still unadjudicated.

In his Second Petition for Rehearing, on his former Petition for Certiorari, the petitioner asked this Court to rule whether Judge Ford's decision was final and appealable. The same issue is now again presented by this Question II.

VI

ARGUMENT BEARING ON QUESTION I

It is ordinarily impossible to prove bad faith in the presentation of affidavits, untested by cross-examination.

It was possible to prove bad faith in the present instance only by reason of the unusual circumstance that the same affiant, who was speaking to the lay District Court, was, at the same time, speaking, in his text book, to a different audience, namely, scientists, engineers and students. To that different audience, Professor Edson did not dare make any untrue statements. As Wigmore says, Third Edition, 1940, vol. 6, 1692 (b) and (c),

> The writer of a learned treatise publishes primarily for his profession. He knows that every conclusion will be subjected to careful professional criticism, and is open ultimately to certain refutation if not well-founded; that his reputation depends on the correctness of his data and the validity of his conclusions; and that he might better not have written than put forth statements in which may be detected a lack of sincerity of method and accuracy of results. * * * It must be conceded that those who write with no view to litigation are at least as trustworthy, though unsworn and unexamined, as perhaps the greater portion of those who take the stand for a fee from one of the litigants.

In contrast to the trustworthiness of what is contained in Professor Edson's book, attention may be invited to what Wigmore says in volume II, section 563, relating to what

> has been declaimed about the *partisanship* and consequent untrustworthiness of the usual professional man as an expert witness (italics in the original).

Wigmore considers that the "bias or pecuniary subserviency" of the professional man as an expert witness,

> when it is discovered, is in a more marked and unpleasant contrast with that ideal of impartiality and trustworthiness which is naturally associated with abstract scientific truth.

Attention is invited to the comments of the courts relating to the type of expert witness referred to here by Wigmore. *Hardinge Conical Mill Co. v. Abbe Engineering Co.*, 2 Cir., 1912, 195 F. 936, 939; *Union Sulphur Co. v. Freeport Texas Co.*, D. C. Del. 1918, 251 F. 634, 662-663; *Hatmaker v. Dry Milk Co.*, D. C. S. D. N. Y., 1929, 29 F. 2d 918, 922; *Steinfur Patents Corporation v. Philip Singer & Bro.*, D. C. S. D. N. Y., 1930, 44 F. 2d 226, 227; and *Opp v. Pryor*, 1920, 294 Ill. 538, 128 N. E. 580, 583.

The petitioner contends that the uncontroverted allegations of Professor Chaffee's and Professor Bowles' affidavits establish bad faith within the meaning of Rule 56 (g), quoted above.

The petitioner contends further that the fact of bad faith becomes reinforced by the additional attempts by the respondent to deceive the District Court, under the principles laid down by Mr. Justice Story in *Wood v. United States,* 16 Pet. 342, 360-361 and *Bottomley v. United States,* 3 F. C. 968, Case No. 1688, pages 971-972, as reiterated, for example, by Judge Taft, *Penn Mut. Life Ins. Co. v. Mechanics Savings Bank & Trust Co.,* 6 Cir., 1896, 72 F. 413, 422:

> It is a well-established rule of evidence that, where the issue is the fraud or innocence of one in doing an act having the effect to mislead another, it is relevant to show other similar acts of the same person having the same effect to mislead, at or about the same time, or connected with the same general subject-matter.

The petitioner invites attention to the similar "deliberately planned and carefully executed scheme to defraud" referred to in *Hazel-Atlas Glass Co. v. Hartford-Empire Co.,* 322 U. S. 238, 245. Reference may be made also to *General Excavator Co. v. Keystone Driller Co.,* 6 Cir., 1932, 62 F. 2d 48, aff. 290 U. S. 240, *Sutter v. Easterly,* 1945, 354 Mo. 282, 189 S. W. 2d 284, 287-288, 162 A. L. R. 437, 442-443 and *Root Refining Co. v. Universal Oil Products Co.,* 3 Cir., 1948, 169 F. 2d 514, certiorari denied, 335 U. S. 912, rehearing denied, 336 U. S. 915.

Attention may be invited also to *Kingsland vs. Dorsey,* 338 U. S. 318. All that Dorsey did in that case was to collaborate in the presentation to the Patent Office of a ghost-written article that was, however, entirely true. He was disbarred, nevertheless, merely because he had misled

the Patent Office with respect to the authorship of the article, representing it as written by a "reluctant witness". His representation, moreover, was not even under oath.

VII

ARGUMENT BEARING ON QUESTION II

The petitioner contends that the Court of Appeals for the First Circuit did not have jurisdiction of the appeal, because it involved some claims only of one patent only of a group of patents, all of which were charged to be infringed by the same equipment.

This was an issue that the appellant has already once raised, though unsuccessfully, in the Second Petition for Rehearing. Since then, however, this Court has consented to consider substantially the same issue, *Sears, Roebuck & Co. v. Bruce A. Mackey et al.*, No. 34, October Term, 1955, and two further petitions for certiorari, relating to substantially the same issue, are pending, *The Cold Metal Process Company* and *The Union National Bank of Ohio, Trustee v. United Engineering & Foundry Company*, No. 76, October Term, 1955, and *Pierce v. Hewlett-Packard Company et al.*, No. 189, October Term, 1955.

In his said Second Petition for Rehearing, the petitioner cited the same cases, and explained the same conflict, that are cited and explained in the *Mackey* and the *Cold Metal Process Company* cases. The only difference is that, in the meantime, additional cases have made their appearance, and the conflict has become only the more confused. The most recent cases appear to be *Newburgh Moire Company, Inc. v. Superior Moire Company, Inc.*, 3 Cir., 1954, 218 F. 2d 580, 583, *Steiner v. 20th Century-Fox Film Cor-*

poration, 9 Cir., 220 F. 2d 105 and *United Artists Corporation v. Masterpiece Productions,* 2 Cir., 1955, 221 F. 2d 213.

Under the ruling in *ex parte National Enameling and Stamping Company, Petitioner,* 201 U. S. 156, 160, the question as to whether the apparatus of the defendants is free of infringement of the remaining patents, and even whether it is free of infringement of the remaining claims in suit of even the one patent, will still need to be adjudicated before there can be a final decision upon the petitioner's claim (or cause of action, as it used to be called).

In addition, just as in the *Cold Metal Process Company case* referred to on page 3, *supra,* there is also a counterclaim which has not yet been adjudicated (R. 25a).

It is believed, therefore, that, in accordance with the decisions in other jurisdictions, the order granting the motion for partial summary judgment was interlocutory, and not final, and that the Court of Appeals for the First Circuit, therefore, took jurisdiction of the appeal contrary to the statute, 28 U. S. C. 1291.

Any other construction of Rule 54(b), indeed, would appear to raise the question whether this Court had authority to formulate Rule 54(b), within the limitations of 28 U. S. C. 2071 and 2072.

Presumably, the reason why this Court declined to consider this issue at the time of the earlier Petition for Certiorari is that the decision was at that time not final. *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.,* 240 U. S. 251, 254, 257, 258.

The District Court has now, however, awarded costs, the Court of Appeals has affirmed, and the case now, therefore, is clearly final, within the meaning of that term. *Forgay v. Conrad,* 6 How. 201, 12 L. Ed. 404. *Radio Station WOW v. Johnson,* 326 U. S. 120, 65 S. Ct. 1475. *Kasishke v. Baker,* 10 Cir., 1944, 144 F. 2d 384.

The petitioner would ask reconsideration of the dismissal of the said Second Petition for Rehearing or, in the alternative, that the issue raised thereby be considered on this petition for certiorari. Since the Court of Appeals had no jurisdiction of the appeal, its judgment is void. Certiorari "is manifestly a more decorous, as well as a more appropriate, form of proceeding than a writ of mandamus to the Circuit Court to disregard the [void] mandate of the appellate court." *American Construction Company v. Jacksonville, Tampa and Key West Railway Company,* 148 U. S. 372, 388.

VIII

REASONS FOR GRANTING THE WRIT

Question I

This appears to be a case of first impression. An important question is therefore presented, bearing upon Rule 56 (g) of the Federal Rules of Civil Procedure, which has not been, but should be, settled by this Court.

A motion for summary judgment is an innovation that was introduced by Rule 56 of the Federal Rules of Civil Procedure. Those who drafted the rule were fully aware of the dangers involved in permitting a case to be decided on the basis of statements made in *ex parte* affidavits, not subject to cross-examination. It was in order to minimize those dangers that they provided the safeguard of this Rule 56 (g).

There have been decisions to the effect that even allegations not under oath, made in bad faith, are subject to censure. *American Automobile Ass'n., Inc. v. Rothman,* D. C. E. D. N. Y. 1952, 104 F. Supp. 655, *Abalene Extermi-*

nating Co., Inc. v. Oser, 1939, 125 N. J. Eq. 329 (N. J. Ch.), 5 A. 2d 738.

It is believed to be ever so much more important to assure, insofar as possible, that allegations under oath should be made in good faith. *Levin Bros. v. Davis Mfg. Co.*, 8 Cir., 1934, 72 F. 2d 163, 166.

To quote from *Kruger v. Resnick*, C.C.P.A. 1952, 197 F. 2d 348, 352:

> It seems to us that if counsel in a controversy seriously suspects the existence of fraud or perjury he, in the proper discharge of his responsibilities to his client and to the public as well, should exercise diligence in bringing such charges in timely fashion to the attention of the appropriate officials.

This Court offered a similar criticism in *Precision Instrument Manufacturing Co. v. Automatic Maintenance Machinery Co.*, 324 U. S. 806, 819:

> Automatic knew of and suspected the perjury and failed to act so as to uproot it and destroy its effects.

The petitioner considers it to be his duty, therefore, to invite this Court's attention to this matter.

Question II

It is important also to know just what is the proper construction of Rule 54(b) of the Federal Rules of Civil Procedure. This is an issue that, as before stated, page 3, is already before this Court in another Petition for Certiorari, and that is being raised also in at least two additional Petitions for Certiorari.

IX

CONCLUSION

For the reasons stated, it is respectfully submitted that this Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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APPENDIX

The Statutes Involved

28 U. S. C., Section 1254 (1).

Cases in the Courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree.

28 U. S. C., Section 1291. Final Decisions of District Courts.

The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the District Court of the Territory of Alaska, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. *As amended Oct. 31, 1951, c. 655, § 48, 65 Stat. 726.*

28 U. S. C., Section 2071. Rule-making Power Generally.

The Supreme Court and all courts established by Act of Congress may from time to time prescribe rules for the conduct of their business. Such rules shall be consistent with Acts of Congress and rules of practice and procedure prescribed by the Supreme Court. *As amended May 24, 1949, c. 139, § 102, 63 Stat. 104.*

28 U. S. C., Section 2072. Rules of Civil Procedure for District Courts.

The Supreme Court shall have the power to prescribe, by general rules, the forms of process, writs, pleadings, and

motions, and the practice and procedure of the district courts of the United States and of the District Court for the Territory of Alaska in civil actions.

Such rules shall not abridge, enlarge or modify any substantive right and shall preserve the right of trial by jury as at common law and as declared by the Seventh Amendment to the Constitution.

Such rules shall not take effect until they have been reported to Congress by the Chief Justice at or after the beginning of a regular session thereof but not later than the first day of May, and until the expiration of ninety days after they have been thus reported.

All laws in conflict with such rules shall be of no further force or effect after such rules have taken effect. Nothing in this title anything therein to the contrary notwithstanding, shall in any way limit, supersede, or repeal any such rules heretofore prescribed by the Supreme Court. *As amended May 24, 1949, c. 139, § 103, 63 Stat. 104; July 18, 1949, c. 343, § 2, 63 Stat. 446; May 10, 1950, c. 174, § 2, 64 Stat. 158.*

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CASE CITED:

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Supreme Court of the United States

No.

GEORGE WASHINGTON PIERCE,

Petitioner,

—v.—

AMERICAN COMMUNICATIONS COMPANY, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioner's Argument

As we understand him, Petitioner is asking that this Court reverse an order granting Respondent's costs and refusing to grant costs to Petitioner because, according to Petitioner:

I. Respondent should pay the costs Petitioner incurred as a result of an allegedly false affidavit by Professor Edson; and

II. The summary judgment entered in this case was not a final judgment.

As to II, the petition should be dismissed on Petitioner's own admission (Petition page 12) that it is the same as the question which he presented to this Court in his "Sec-

ond Petition for Rehearing on his former Petition for Certiorari," and which was denied (348 U. S. 851).

THE ONLY QUESTION BEFORE THIS COURT IS WHETHER AN AWARD OR DENIAL OF COSTS IN THE DISTRICT COURT IS APPEALABLE. THE ANSWER IS NO. *Dubois* v. *Kirk*, 158 U. S. 58, 67 (1895).

There Has Been No Bad Faith on the Part of Respondent's Expert or Counsel

We believe that the foregoing is a complete answer to the petition. However, since Petitioner has again seen fit to level invectives at opposing expert and counsel we shall briefly answer lest our silence be construed as an admission of the completely unfounded charges.

Ever since the Court of Appeals reversed Judge Ford and held the Pierce patent invalid, Petitioner has unsuccessfully sought via numerous petitions and writs to reargue the merits of the case on the ground that Respondent's counsel had misled the Court.

We stand behind everything we said in our briefs and oral arguments and would repeat them if called upon to reargue the case.

The Edson Affidavit

There is no substance in Petitioner's charge that Professor Edson's original affidavit (R. 129a-165a) was false. Professor Edson said (R. 135a):

> "My retainer in this case afforded me (in October 1951) the opportunity of studying the history of this part of the radio art. Prior to that time I had assumed that Doctors Miller and Pierce were the origi-

nators of the circuits named for them. I now know that the work of Doctors Miller and Pierce, done in 1923, 1924 was anticipated by the work of A. M. Nicolson in 1918 and also by the work of W. G. Cady in 1921.

"Professor Bowles in his affidavit section 12 makes much of the fact that a particular oscillator circuit is commonly referred to as the 'Pierce-oscillator' and that another circuit is called the 'Miller' or 'Pierce-Miller.' However, in scientific circles the attachment of a name is often based upon early publication rather than on knowledge who the true inventor may be. For example, the 'Wheatstone bridge,' which is far more widely known than the Pierce type circuit was not invented by Wheatstone. On this point Professor Frederick A. Sanders (A Survey of Physics, Third Edition, 1944, Henry Holt & Co., New York) says, at page 380:

> "'A more accurate method of measuring resistances depends on a "bridge circuit" invented by Christie (1833) but usually known as the Wheatstone Bridge.'"

In his text book, the forthcoming publication of which was indicated in the affidavit, Professor Edson referred to an electrical circuit as a "Pierce" circuit.

The present case was the first judicial inquiry as to whether the work of Nicolson preceded and anticipated that of Pierce. Prior to this case, the only judicial inquiry had been as to priority rights between Miller and Pierce.

It was Professor Edson's opinion as expressed in his affidavit that Nicolson (as well as Cady) had the piezo-electric crystal controlled oscillator before Pierce and that the invention in the patent in suit had been claimed by

Pierce in his expired patent 1,789,496 (the latter opinion was shared by the Court of Appeals).

As stated in his second affidavit (R. A41-A43) Edson did not think that an engineering text book was the proper medium for discussing inventorship, but that familiar terminology should be employed.

In support of his opinion that Nicolson and Cady were ahead of Pierce, Professor Edson showed the following in his affidavit.

He quoted (R. 145a) three claims from Nicolson patent 2,212,845, and stated "These claims describe the same oscillator as in the Pierce claims which Professor Bowles construes in Section 13 [one of plaintiff's experts]."

Professor Edson then (R. 145a) referred to the following passage from page 287 of Professor Cady's book (which was introduced as *petitioner's* exhibit VI) to show that Pierce was not the first to construct a crystal-controlled oscillator:

> "Recently, the author was informed by Dr. Nicolson that he found in September, 1917, that the circuit represented in his Fig. 11 must have been oscillating at a frequency determined by a natural mode of the Rochelle-salt crystal. It is most unfortunate that the evidence was not published. In view of this statement, however, it appears that Nicolson was the first to construct a crystal-controlled oscillator—unless, indeed, Langevin's circuit was to some extent crystal controlled. Such findings were entirely unknown to the author in his investigations described above."

Long before this litigation started, Professor Pierce himself recognized the likelihood that Nicolson might have a piezo-electric crystal-controlled oscillator as defined in the

Nicolson claims, for we find in his license agreement with the American Telephone & Telegraph Company (R. 621a):

> "It is further agreed that as between the parties hereto the allowance in the applications of Nicolson Ser. No. 631,869* and Ser. No. 685,010 of any claims which the Patent Office shall determine are properly supported by the disclosures of said applications respectively, will not be contested by the other parties."

As point 10 of his affidavit, Professor Edson quoted (R. 147a) claim 1 of Cady patent No. 1,472,583 which, in his opinion described the same oscillator as Pierce patent 2,133,642 (the patent in suit).

The foregoing brief excerpts from Professor Edson's affidavit, show that his opinion concerning the Pierce patent was well-founded and the result of a careful and thorough study of the subject matter.

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* Ser. No. 631,869 is a misprint for Ser. No. 631,859 which resulted in Nicolson patent 2,212,845 (R 581a).

CONCLUSION

Under the guise of raising questions concerning Rules 54(b) and 56(g), Petitioner is attempting once more to get before the Court the merits of the case. The District Court did not consider Petitioner's contentions worthy of an opinion, and the Court of Appeals affirmed *Per Curiam*. This petition should likewise be summarily denied.

Respectfully submitted,

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